

Applicant: Shintaro Asano
U.S.S.N.: 09/802,093

REMARKS

In response to the Final Office Action mailed March 11, 2004, Applicant respectfully requests reconsideration. To further the prosecution of the application, claim 16 has been cancelled and claim 12 has been amended. Claims 12, 13 and 17-30 are pending in the application with claims 12, 22 and 27 being in independent form. The claims as presented are believed to be in allowable condition.

Interview with Examiner

Applicant would like to thank the Examiner for holding a telephonic interview with the undersigned Applicant's Attorney for the application on June 10, 2004. During the interview, the rejections of independent claims 22 and 27 were discussed. Specifically, Applicant's Attorney pointed out that the reference, Galipeau et al, used in the 102 rejection of claims 22 and 27 does not include all of the limitations of the claims. While no specific agreement was reached, the Examiner did agree to reconsider the arguments when presented in this response. The arguments for patentability presented during the interview are provided below.

During the interview, Applicant's Attorney also requested the Examiner to remove the finality of the Office Action as the final rejection is believed to be premature. The Examiner stated that the Applicant's prior amendment necessitated the new grounds of rejection and that therefore, the finality of the Office Action was proper. The Applicant's Attorney agreed to review the prior response and address this issue further in this response.

Finality of Office Action

As discussed with the Examiner during the interview, the finality of the Office Action is premature and should be withdrawn. Based on the reasons presented below, Applicant respectfully requests that the finality be withdrawn.

The Final Office Action is the second office action for the present application. The First Office Action issued on September 26, 2003. In the First Office Action, claims 1-14 and 17-21 were rejected and claims 15 and 16 were objected to but indicated as allowable if written in independent form to include all of the limitations of their base claim and any intervening claims.

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In response to the First Office Action, claim 12, which was the base claim for claim 15, was amended to include the limitations of claim 15, and intervening claim 14. Claims 14 and 15 were cancelled and claim 12 as amended was the equivalent of previously presented claim 15. Claim 16 was amended to depend from claim 12, as it previously depended from claim 15. Claim 16 as presented after the amendment was equivalent to claim 16 prior to the amendment. In the response to the Office Action, claims 1-11 were also cancelled, and claims 22-30 were added to the application.

In the Final Office Action, claim 12 was rejected under new grounds (see paragraph 20 of the Final Office Action). In Paragraph 20 of the Office Action, it is acknowledged that claim 12 contains the subject matter of claim 15, but the paragraph further states that the subject matter is no longer allowable based on the new rejection of claim 12. The Final Office Action (paragraph 22) states that Applicant's Amendment necessitated the new ground of rejection.

In accordance with MPEP §706.07(a), a second office action should not be made final when there is a new ground of rejection not necessitated by applicant's amendment. The new ground of rejection for claim 12 in the present application was not necessitated by the amendment to claim 12, since claim 12 is the same as claim 15 which was previously presented and indicated as containing allowable subject matter. Accordingly, Applicant respectfully requests that the finality of the office action be withdrawn as premature in accordance with MPEP §706.07(d).

Allowable Subject Matter

Claim 16 has been objected to in the Final Office Action, but indicated as allowable if rewritten to include all of the limitations of its base claim and any intervening claims. Independent claim 12, from which claim 16 previously depended, has been amended to include all of the limitations of claim 16, and claim 16 has been cancelled. Accordingly, claim 12 is in allowable condition.

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Claim Rejections under 35 U.S.C. §103

Claims 12, 13 and 17-21 have been rejected under 35 U.S.C. §103 as being unpatentable over Shannon (U.S. Patent No. 5,799,147) in view of Fink (U.S. Patent No. 6,289,463). Without acceding to the correctness of the rejection, and reserving the right to pursue the original subject matter in continuation applications, claim 12 has been amended to include the subject matter of claim 16, and as discussed above is in allowable condition.

Claims 13, 17 and 21 depend from claim 12 and are allowable for at least the same reasons.

Claim rejections under 35 U.S.C. 102

Claims 22-30 have been rejected under 35 U.S.C. §102(e) as being anticipated by Galipeau et al. (USPN 20020049925A1). As discussed below and with the Examiner during the interview, Applicant respectfully traverses this rejection.

Galipeau is directed to a system and method for mirroring files across a network (see Abstract). In the system of Galipeau, a copy of a data file is stored in a local location and a copy of that data file is mirrored in a remote location. When a change to a file occurs, both the local and the remote copy of the file are updated with the changes. (Par. 0027). Change information is transmitted from the local computer to the remote computer over a network (see Abstract). The system of Galipeau is similar in some respects to systems described in the background of the present application that provide back-up data over the Internet. (see page 1, lines 27-33 of the specification of the present application).

Claim 22 is directed to a method of remotely monitoring a data back-up process associated with a first computer and a storage device operatively coupled to the first computer. The method includes receiving an electronic message at a second computer sent over a network by the first computer, wherein the second computer is located remotely from the first computer and the storage device, and the message indicates that the first computer is prepared to start a data back-up process, sending an electronic message from the second computer to the first computer to instruct the first computer to start the data back-up process, using the second

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computer, monitoring over the network the back-up process being performed by the first computer, and sending a message from the second computer indicating a status of the back-up process.

The method of claim 22 provides for remote monitoring of a data back-up process rather than mirroring of data over a network as described by Galipeau, and because of this difference, the system of Galipeau is different from and does not anticipate the method of claim 22. More specifically, claim 22 recites a method in which a second computer monitors a back up process on a first computer. As part of this process, the second computer sends an electronic message to the first computer to instruct the first computer to start the data back-up process. Galipeau does not disclose or suggest a system or method in which one computer, which is monitoring a backup process on another computer, sends an electronic message to the other computer to start a data back-up process as in the method recited in claim 22. Further, this limitation of claim 22 is not discussed by the Examiner during the discussion of claim 22 in Paragraph 11 of the Office Action. Based on the foregoing, claim 22 is patentably distinguishable over Galipeau, and rejection of claim 22 under 35 U.S.C. §102(e) should be withdrawn.

Claims 23-26 depend from claim 22 and are patentable for at least the same reasons.

Claim 27 is directed to a system for remotely monitoring over a network a data back-up process associated with a remote computer and a storage device operatively coupled to the remote computer. The system includes a network computer having a network connection to couple the network computer to a network, the network computer being programmed to, receive an electronic message sent over the network by the remote computer, wherein the message indicates that the remote computer is prepared to start a data back-up process, to send an electronic message to the remote computer to instruct the remote computer to start the data back-up process, to monitor the data back-up process being performed by the remote computer, and to send a message indicating a status of the back-up process.

Claim 27 is a system claim that is similar in some aspects to method claim 22 and is patentable over Galipeau for reasons similar to those of claim 22 discussed above. Specifically, claim 27 is directed to a system that remotely monitors a data back up process and includes among other things, a network computer that is programmed to send an electronic message to a remote computer to instruct the remote computer to start a data back-up process. As discussed

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above with respect to claim 22, Galipeau does not disclose or suggest a system or method in which one computer, which is monitoring a backup process on another computer, sends an electronic message to the other computer to start a data back-up process. Further, this limitation is not addressed by the Examiner in the rejection of claim 27. Based on the foregoing, claim 27 is patentably distinguishable over Galipeau, and the rejection of claim 27 under 35 U.S.C. §102 should be withdrawn.

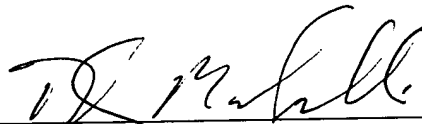
Claims 28-30 depend from claim 30 and are patentable for at least the same reasons.

CONCLUSION

Based on the foregoing, this application is believed to be in allowable condition and a notice to that effect is respectfully requested. If the Examiner has any questions, he/she is invited to contact the Applicant's Attorney at the number provided below.

Respectfully submitted,

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